



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,963	09/20/2001	Hiroshi Sumiyama	018775-842	1910

7590 11/26/2008
Platon N. Mandros
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404

EXAMINER

HANG, VU B

ART UNIT	PAPER NUMBER
----------	--------------

2625

MAIL DATE	DELIVERY MODE
-----------	---------------

11/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/955,963	Applicant(s) SUMIYAMA ET AL.	
	Examiner Vu B. Hang	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/19/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- This office action is responsive to the Request for Continued Examination filed on 10/30/2008.
- The amendment received on 10/07/2008 have been entered and made of record.
- Claims 1-26 are pending in the application.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/07/2008 has been entered.

Response to Arguments

2. Applicant's arguments filed 10/07/2008 have been fully considered but they are not persuasive. The applicant argues that the cited prior art, Aina (US Patent 5,663,800) and Nishiyama et al. (US Patent 6,067,168), does not disclose or suggest a memory recall key that can be used to directly recall data from one device to another. For support, the applicant further argues that Nishiyama does not disclose or suggest that the user can control the issuance of a return request. The examiner disagrees for the following reasons.

3. Nishiyama discloses a memory mode transmission key on an image processing device for sending a document data to another device after the documents is stored in memory (see Fig.5 (20) and Col.10, Line 5-9). The examiner interprets this memory mode transmission key as a "memory recall" key for performing re-execution of an output instruction. The output instruction

Art Unit: 2625

would be to retransferring the processed image data back to the sender device. Nishiyama also teaches that the processed image data is returned to the sender device (copier 91) upon receiving a "return request" signal by the machine performing the image processing (see Fig.1 (S54), Fig.15 (S14,S15,S16,S10) and Co1.17, Line 42-48); and that a user can input control data through a user interface from the sender device (copier 91) to send image processing and control information to specific devices (copier 92 and copier 93) that are communication with the requesting machine (see Fig. 13b, Fig.13c and Co 1.16, Line 4- 18). This shows that the input keys from the user interface of a device can generate a return request signal for returning the processed image data to the sender machine. Therefore in the examiner's opinion, Nishiyama teaches a memory recall key that can be used to directly recall data from one device to another.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ainai (US Patent 5,663,800) in view of Nishiyama et al. (US Patent 6,067,168).

6. Regarding **Claims 1 and 17**, Anai discloses an image forming apparatus (see Fig.3 and Col.2, Line 17-22), comprising: an input device for receiving image data as an input (see Fig.3 (1) and Col.6, Line 59-66); transfer means for transferring the image data received by the input device to an image memory of a memory incorporating apparatus connected to the input device via the network (see Fig.3 (1,6,7) and Col.3, Line 45-50); and a printing device for forming an

Art Unit: 2625

image with use of the image data received by the reception means (see Fig.3 (3)). Aina fails to disclose a memory recall key which generates a memory recall signal after a transfer of the image data, for re-execution of an output instruction; and a reception means for receiving the image data stored in the image memory in accordance with the signal.

7. Nishiyama, however, discloses a memory mode transmission key on an image processing device for sending a document data to another device after the documents is stored in memory (see Fig.5 (20) and Col.10, Line 5-9); and a reception means for receiving the image data stored in the image memory in accordance with a signal (see Fig. 6 - Fig.9 and Col. 10, Line 21-58). Nishiyama also teaches that the processed image data is returned to the sender device (copier 91) upon receiving a "return request" signal by the machine performing the image processing (see Fig.1 (S54), Fig.15 (S14,S15,S16,S10) and Co1.17, Line 42-48); and that a user can input control data through a user interface from the sender device (copier 91) to send image processing and control information to specific devices (copier 92 and copier 93) that are communication with the requesting machine (see Fig. 13b, Fig.13c and Co 1.16, Line 4- 18).

8. Aina and Nishiyama are combinable because they are from the same field of endeavor, namely image processing systems. At the time of the invention, it would have been obvious for one skilled in the art to include to the apparatus a memory recall key which generates a memory recall signal after a transfer of the image data, for re-execution of an output instruction; and a reception means for receiving the image data stored in the image memory in accordance with the signal. The motivation would be to include a user interface for sending and distributing print commands from a requesting device to other image-forming devices in communication with the requesting device, and receiving back the processed image data upon request. The user interface

Art Unit: 2625

would enable an operator from the requesting device to send image data to a more capable device to perform specific image processing on the image data, and receiving back the processed image data upon request.

Regarding **Claims 2 and 10**, Ainaï further discloses a retrieval means for retrieving the image data in the memory of the memory-incorporating apparatus connected to the network (see Fig.3 (6,7), Col.3, Line 18-29 and Col.3, Line 45-50).

Regarding **Claims 3 and 11**, Ainaï discloses the transfer means of Claim 2 but fails to disclose a transfer means for transferring the image data to the image memory of the memory-incorporating apparatus retrieved by the retrieval means. Nishiyama, however, discloses a transfer means for transferring the image data to the image memory of the memory-incorporating apparatus retrieved by the retrieval means (see Col.2, .Line 66 - Col.3, Line 3). At the time of the invention, it would have been obvious for one skilled in the art to include a means for transferring the image data to the image memory of the memory-incorporating apparatus retrieved by the retrieval means. The motivation would be to provide an image data storage means in which the stored image data can be retrieved for repeat printings. The storage means would benefit printings in which the same image data are repeatedly used.

Regarding **Claims 4 and 12**, Nishiyama further discloses a warning device for informing a user that the retrieval means cannot identify any memory-incorporating apparatus (see Col. 18, Line 47-49). At the time of the invention, it would have been obvious for one skilled in the art to include the warning device. The motivation would be to detect the presence of image data to be printed. A user trying to perform a printing operation should be notified when there are no image data present to be printed.

Regarding **Claims 5 and 13**, Ainai further discloses a transfer instructions means for inputting a data transfer instruction in response to operation by a user (see Fig. 1 (1,6) and Col.6, Line 63-66), wherein the retrieval means retrieves the image data in the image memory of the memory-incorporating apparatus when the data transfer instruction is inputted (see Fig. 1 (1,6), Col.3, Line 18-29 and Col.3, Line 45-50).¹⁰ Regarding Claims 6 and 14, Nishiyama further discloses the key is displayed on a display device (see Fig.6 - Fig.9 and Col.4, Line 46-48).

Regarding **Claims 7 and 15**, Nishiyama further discloses a user interface display that identifies the memory-incorporating apparatus (see Fig.8a and Col. 11, Line 7-12) and determining whether the memory-incorporating apparatus is able or unable to store image data request (see Fig.27 (118) and Col.32, Line 47-55). Ainai and Nishiyama, however, fail to disclose "not displaying the key when the retrieval means identifies a no-memory-incorporating apparatus". Official notice is taken that it is well known in the art at the time of the invention to remove a key or menu after the option is no longer available. It would have been obvious to remove the key if the retrieval means identifies a no-memory-incorporating apparatus. The motivation would be to minimize confusions and time wasted for viewing options that are no longer in use.

9. Regarding **Claims 8 and 16**, Nishiyama further discloses the key is displayed on the display device during or after image forming operation by the printing device with use of image data inputted by the input device (see Fig. 17 (121a) and Col.4, Line 43-51).

10. Regarding **Claim 9**, Ainai discloses an image forming apparatus (see Fig.3 and Col.2, Line 17-22), comprising: a buffer for holding the image data created by the reading device (see Fig.3 (5a-c) and Col.3, Line 23-29); a printing device for forming a copy of the image document

Art Unit: 2625

on a sheet of paper based on the image data held in the buffer (see Fig.3 (3)); a transfer means for transferring the image data stored in the buffer to an image memory of a memory-incorporating apparatus connected to a network via the network; and a control means for controlling the printing device which forms an image with use of the image data received by the reception means (see Fig.3 (1,6,7) and Col.3, Line 45-50); and a control means for controlling the printing device, which forms an image with use of the image data received by the reception means (see Fig.3 (1,3,6) and Col.6; Line 59-66). Aina fails to disclose a reading device; a memory recall key which generates a memory recall signal after a transfer of the image data, for re-execution of an output instruction; and a reception means for receiving the image data stored in the image memory in accordance with the signal.

11. Nishiyama, however, discloses a reading device for creating data by reading an image document (see Fig. 11 (91-93) and Col. 12, Line 56-62), a memory mode transmission key on an image processing device for sending a document data to another device after the documents is stored in memory (see Fig.5 (20) and Col.10, Line 5-9); and a reception means for receiving the image data stored in the image memory in accordance with a signal (see Fig. 6 - Fig.9 and Col. 10, Line 21-58). Nishiyama also teaches that the processed image data is returned to the sender device (copier 91) upon receiving a "return request" signal by the machine performing the image processing (see Fig.1 (S54), Fig.15 (S14,S15,S16,S10) and Col.17, Line 42-48); and that a user can input control data through a user interface from the sender device (copier 91) to send image processing and control information to specific devices (copier 92 and copier 93) that are communication with the requesting machine (see Fig. 13b, Fig.13c and Co 1.16, Line 4- 18).

Art Unit: 2625

12. Aina and Nishiyama are combinable because they are from the same field of endeavor, namely image processing systems. At the time of the invention, it would have been obvious for one skilled in the art to include to the apparatus a memory recall key which generates a memory recall signal after a transfer of the image data, for re-execution of an output instruction; and a reception means for receiving the image data stored in the image memory in accordance with the signal. The motivation would be to include a user interface for sending and distributing print commands from a requesting device to other image-forming devices in communication with the requesting device, and receiving back the processed image data upon request. The user interface would enable an operator from the requesting device to send image data to a more capable device to perform specific image processing on the image data, and receiving back the processed image data upon request. It is further obvious to include to the apparatus a reading device for creating the image data. The motivation would be to scan or read in image data to perform specific image processing on. The scanned or read image data would be input data for the apparatus to perform specific image processing on.

13. Regarding **Claim 18**, the rational provided for the rejection of Claim 9 is incorporated herein.

14. Regarding **Claim 19**, the rational provided for the rejections of Claim 1 is incorporated herein.

15. Regarding **Claim 20**, the rational provided for the rejection of Claim 9 is incorporated herein.

16. Regarding **Claims 21**, Aina further discloses wherein the image forming apparatus does not have an image memory (see Fig.3 (1) and Col.2, Line 17-22).

Art Unit: 2625

17. Regarding **Claim 22-26**, the rationale provided for the rejection of Claim 9 is incorporated herein.

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vu B. Hang whose telephone number is (571)272-0582. The examiner can normally be reached on Monday-Friday, 9:00am - 6:00pm.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vu B. Hang/
Examiner, Art Unit 2625

/David K Moore/
Supervisory Patent Examiner, Art Unit 2625

Application/Control Number: 09/955,963
Art Unit: 2625

Page 10